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In re Appln. Of: FURUMIYA et al.

Serial No.: 10/688,000

Filed: October 17, 2003

For: SEMICONDUCTOR INTEGRATED CIRCUIT DEVICE

Group: 2822 Confirmation No. 4404

Examiner: Tran, Thanh Y. DOCKET: NEC 03FN026

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND OF EXTENSION FEE

Dear Sir:

On June 14, 2005, the Patent Office mailed an Action to the Applicants' undersigned attorney, which Action indicated a response was due 3-months from the mailing date, or September 14, 2005. A copy of the Action is attached hereto as Exhibit A.

Applicants' response was timely filed within the three-month period, i.e., August 19, 2005, under Certificate of Mailing (see Exhibit B). Notwithstanding, the Patent Office charged a two-month extension of time fee to Deposit Account No. 081391 (see attached copy of Monthly Statement of Deposit Account dated 9-30-05 attached for 10688000, Fee Code 1252 for 450.00 (Exhibit C)).

Thus, Applicants' response was timely filed within the term set by the PTO Examiner, and the charge for an extension is not warranted.

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Serial No. 10/688,000
Docket No. NEC 03FN026
Request for Refund of Extension Fee

Applicants' attorney respectfully requests a refund of the \$450 extension fee, and credit of same to Deposit Account No. 081391.

Respectfully submitted,



Norman P. Soloway
Attorney for Applicants
Reg. No. 24,315

Attachments:
Exhibits A, B and C

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 20, 2006, at Tucson, Arizona.

NPS/dd

By M. Diane Sube

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**EXHIBIT A (OFFICE ACTION MAILED 06/14/05)
TO REQUEST FOR REFUND OF EXTENSION FEE**

Serial No. 10/688,000

(Attorney Docket No. NEC 03FN026)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,000	10/17/2003	Masayuki Furumiya	NEC 03FN026	4404
27667	7590	06/14/2005	PENDING	
HAYES, SOLOWAY P.C. 130 W. CUSHING STREET TUCSON, AZ 85701			JUN 17 2005	EXAMINER TRAN, THANH Y

HAYES SOLOWAY

DATE MAILED: 06/14/2005

7/14/05 10/14/05
3 mos. 8/14/05 11/14/05
9/14/05 12/14/05
allst.

Please find below and/or attached an Office communication concerning this application or proceeding.

COPY



Office Action Summary

Application No.	10/888,000	Applicant(s)	FURUMIYA ET AL.
Examiner	Thanh Y. Tran	Art Unit	2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-13 and 24-34 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Applicant's election of Species I with claims 1-13 in the reply filed on 03/07/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a semiconductor integrated circuit device comprising a decoupling capacitor formed at an interface between the first conductivity type semiconductor substrate and second conductivity type semiconductor layer, classified in class 257, subclass 595.
 - II. Claims 24-34, drawn to a semiconductor integrated circuit device comprising a pn junction between the first region and second region acts as a decoupling capacitor suppressing a variation of at least one of voltage supplied by the first and second power supplies, classified in class 257, subclass 599.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a decoupling capacitor could be used for reducing the frequency noise for the circuitry, however invention II has separate utility such as a decoupling capacitor could suppress a variation of at least one of voltages supplied by first and second power supplies. See MPEP § 806.05(d).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh Y. Tran whose telephone number is (571) 272-2110. The examiner can normally be reached on M-F (9-6:30pm).

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Application/Control Number: 10/688,000
Art Unit: 2822

Page 4

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on (571) 272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYT



AMIR ZARABIAN
PENINSULAR PATENT EXAMINER
TECHNOLOGY CENTER 2800

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**EXHIBIT B (APPLICANTS' RESPONSE MAILED 08/19/05)
TO REQUEST FOR REFUND OF EXTENSION FEE**

Serial No. 10/688,000

(Attorney Docket No. NEC 03FN026)



AMENDMENT B

Appln. Of: FURUMIYA et al.
Serial no.: 10/688,000
Filed: October 17, 2003
For: SEMICONDUCTOR INTEGRATED CIRCUIT DEVICE
Docket: NEC 03FN026

Received: 1. Amendment B (4 pgs)

8/19/05 kmg

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: FURUMIYA et al.

Serial No.: 10/688,000

Filed: October 17, 2003

For: SEMICONDUCTOR INTEGRATED CIRCUIT DEVICE

Group: 2822

Examiner: Tran, Thanh Y.

DOCKET: NEC 03FN026

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT B

Dear Sir:

This Amendment is being filed in response to the Three Month Office Action mailed June 14, 2005.

Remarks/Arguments begin on page 2 of this Amendment.

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REMARKS

In response to the **Three Month Action** mailed June 14, 2005, the restriction requirement is respectfully traversed. The Official Action has not established a *prima facie* justification for the restriction requirement. In the Official Action, the Examiner has required restriction, under 35 USC § 121, between the following groups of claims:

- I. Claims 1-13, drawn to a semiconductor integrated circuit device comprising a decoupling capacitor formed at an interface between the first conductivity type semiconductor substrate and second conductivity type semiconductor layer, classified in class 257, subclass 595, and
- II. Claims 24-34, drawn to a semiconductor integrated circuit device comprising a pn junction between the first region and second region acts [sic] as a decoupling capacitor suppressing a variation of at least one of voltage supplied by the first and second power supplies, classified in class 257, subclass 599.

In making the restriction requirement, the Examiner asserts "Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a decoupling capacitor could be used for reducing the frequency noise for the circuitry, however invention II has separate utility such as a decoupling capacitor could suppress a variation of at least one of voltages supplied by first and second power supplies." Even assuming arguendo invention I may have separate utility, invention I is generic, and invention II falls within the scope of invention I.

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Serial No. 10/688,000
Docket No. NEC 03FN026
Amendment B

In requiring restriction, the Examiner also noted that the inventions are classified in different classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance MPEP § 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between statutory classes of claims unless the claims cover "independent and distinct inventions". It is respectfully submitted that the statutory requirements, not having been met here for Groups I and II respective, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

It should be noted that the restriction requirement as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn. In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicants provisionally elect to prosecute Group I, i.e., claims 1-13, and it is requested that, without further action thereon, claims 24-34 be retained in this application pending disposition of the application, and for possible rejoinder and/or for filing of a divisional application.

An action on the merits is respectfully requested.

While this second Action was a restriction requirement, the Action was marked as being a three month Action. Therefore, it is believed an extension of time is not needed. However, in the event an extension of time is needed, the Commissioner is authorized to consider this a request for extension, and charge our deposit account No. 08-1391 the cost of the extension.

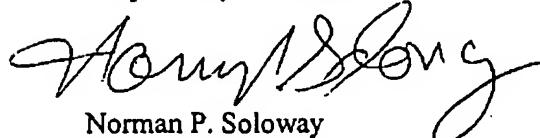
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Serial No. 10/688,000
Docket No. NEC 03FN026
Amendment B

Respectfully submitted,



Norman P. Soloway
Attorney for Applicant
Reg. No. 24,315

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

August 19, 2005, at Tucson, Arizona.

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By



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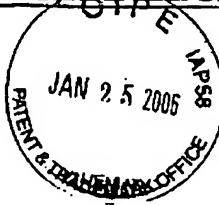
**EXHIBIT C (MONTHLY STATEMENT OF DEPOSIT ACCOUNT 081391)
TO REQUEST FOR REFUND OF EXTENSION FEE**

Serial No. 10/688,000

(Attorney Docket No. NEC 03FN026)



UNITED STATES PATENT AND TRADEMARK OFFICE



**MONTHLY STATEMENT
OF DEPOSIT ACCOUNT**

To replenish your deposit account, detach and return top portion with your check. Make check payable to Director of Patents & Trademarks.

HAYES SOLOWAY P.C.
SANDY GAUDREAU
175 CANAL STREET
MANCHESTER NH 03101

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9 1 05	81	29226763	HS-270 (BOSACO.1007)	8007	80.00	2131.00
9 1 05	82	29226761	HS-269 (BOSACO.1002)	8007	80.00	2051.00
9 1 05	99	29222745	HS-268 (BOSACO.2035)	8007	20.00	2031.00
9 2 05	310	29222745	HS-273 (BOSACO.1001)	8007	20.00	2011.00
9 2 05	312	29226761	HS-271 (BOSACO.2055)	8007	20.00	1991.00
9 2 05	313	29222745	HS-267	8007	20.00	1971.00
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9 7 05	199	29226763	HS-275 (BOSACO.2044)	8007	20.00	1931.00
9 14 05	1	09735005	NEC444	1201	200.00	1731.00
9 15 05	103	29227099	AZ-0021	8007	20.00	1711.00
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